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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,346	02/09/2004	John C. Jaeger	21375	6802

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EXAMINER
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RAMANA, ANURADHA

ART UNIT	PAPER NUMBER
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3733

MAIL DATE	DELIVERY MODE
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12/31/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/773,346

Applicant(s)

JAEGER, JOHN C.

Examiner

Anu Ramana

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2007.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17, 22-29, 31 and 32 is/are rejected.
- 7) ☒ Claim(s) 18-21 and 30 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 11, the phrase "pivotal movement thereof" renders the claim vague and indefinite since it is unclear whether the movement of one blade or several blades is controlled at selected angles.

In claims 8 and 9, the term "biasing means" lacks antecedent basis.

In claim 10, which means recited in claim 1 is the clause "wherein means comprise" referring to.

The Examiner requests that proper means-plus-function language be used if Applicant is trying to invoke 112 sixth paragraph.

Appropriate correction of the above is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

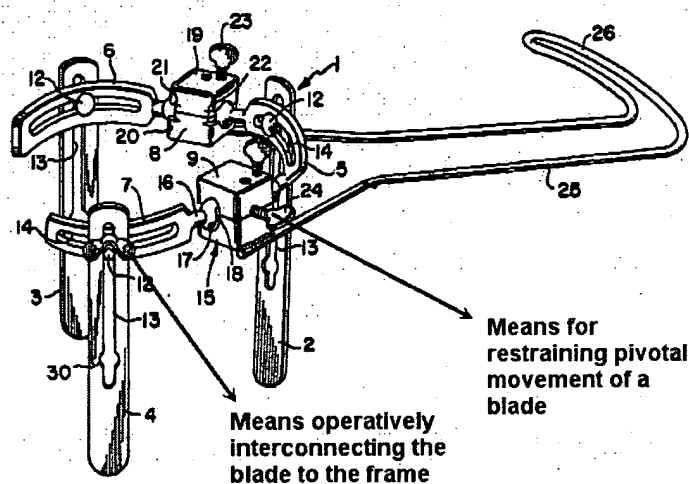
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 4-5, 8, 10, 15-17, 23, 26, 29 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Karlin et al. (US 3,509,873).

Karlin et al. disclose a retractor including: a support frame (defined by support members 6, 7); at least three blades (2, 3, 4); means operatively connecting a blade to the frame; and means for restraining the pivotal movement of a blade (Fig. 1, col. 2, lines 55-72, cols. 3-4 and col. 5, lines 1-53). See marked up Fig. 1 from Karlin et al. below.

Regarding claim 10, Karlin et al. disclose a plurality of blocks 8 and 9, each of which interact with a respective end section of a respective blade by means of members 5, 6 and 7.



Claims 1-6, 10, 15-17, 22-27, 31 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Charters (US 5,916,151).

Charters discloses an instrument for dilating a body cavity including: a control ring or "support frame" 31; at least three blades 11; means operatively interconnecting the support frame and the blade, i.e., 50, for yieldingly biasing the elongated section of a blade into engagement with the elongated section of another blade; and means for restraining pivotal movement thereof at selected angles (Figs. 5, 7 and 9, cols. 3-4 and col. 5, lines 1-19).

Note, during examination, claims must be interpreted as broadly as their terms reasonably allow. This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. In re Zletz, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). Thus, "blade" is being interpreted to be a "long, thin piece" (Source: The American Heritage® Dictionary of the English Language: Fourth Edition. 2000).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7, 14 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Charters (US 5,916,151).

Charters discloses the claimed invention except for the specific shape of the blade and the support frame. It would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to construct the Charters blades with the second end sections and the elongated sections of each blade connected together at a respective hinge to form an acute angle or the support frame with an octagonal shape, since applicant has not disclosed that this solves any stated problem or is anything more than one of numerous shapes or configurations a person of ordinary skill in the art would find obvious for the purpose of providing a blade or a support frame. In re Dailey and Eilers, 149 USPQ 47 (1966).

### ***Response to Arguments***

Applicant's arguments submitted under "REMARKS" in the response filed on August 16, 2007 have been fully considered.

Applicant's arguments with respect to the rejections of claims 1-2, 4-5, 8, 10, 15-17, 23, 26, 29 and 31 as being anticipated by Karlin et al. are not persuasive because Karlin et al. disclose all elements of Applicant's claimed invention as previously discussed in the pertinent rejection.

Applicant's arguments with respect to the rejections of claims 1-6, 10, 15-17, 22-27 and 31 as being anticipated by Charters are not persuasive because Charters discloses all elements of Applicant's invention as previously discussed in the pertinent rejection.

It is noted that a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

### ***Allowable Subject Matter***

Claims 9 and 11-13 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 18-21 and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR  
December 26, 2007

  
ANURADHA RAMANA  
PRIMARY EXAMINER  
TECHNOLOGY CENTER 3700